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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

BEJERANO 2-48

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on August 4, 2008

Signature

Karen Vertz

Typed or printed name Karen Vertz

Application Number

10/672,204

Filed

September 26, 2003

First Named Inventor

Yigal Bejerano

Art Unit

2113

Examiner

Philip A. Guyton

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

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applicant/inventor.

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assignee of record of the entire interest.

See 37 CFR 3.71, Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 33,182

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

David H. Hitt

Typed or printed name

972-480-8800

Telephone number

August 4, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Yigal Bejerano, *et al.*
Serial No.: 10/672,204
Filed: September 26, 2003
Title: SYSTEM AND METHOD FOR MONITORING LINK DELAYS
AND FAULTS IN AN IP NETWORK
Grp./A.U.: 2113
Examiner: Philip A. Guyton Confirmation No.: 8936

Commissioner for Patents
P.O. Box 1450
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Appellants have carefully considered this Application in connection with the Examiner's Final Rejection mailed June 4, 2008. In view of the following remarks, the Appellants respectfully request a Pre-Appeal Review of this Application.

REMARKS/ARGUMENTS

The Appellants originally submitted Claims 1-19 in the Application. The Appellants previously canceled Claims 2, 7, 9, and 14 without prejudice or disclaimer, and have previously added new Claims 20-22. Claims 1, 6, 8, 13, 15, 20, and 22 have previously been amended. Claims 1, 3-6, 8, 10-13, and 15-22 are pending.

I. Rejection of Claims 1, 3-6, 8, 10-13 and 15-22 under 35 U.S.C. §102

The Examiner has rejected Claims 1, 3-6, 8, 10-13 and 15-22 under 35 U.S.C. §102(b) as being anticipated by "Optimizing Probe Selection for Fault Localization" by Brodie *et al.* ("Brodie.") Generally, Brodie specifies node transitions in order to generate a dependency matrix $D(i,j)$, where $D(i,j) = 1$ if the probe is directed through node N_j , and $D(i,j) = 0$ otherwise. Any *failure* in a *node* that has a corresponding unique column in the dependency matrix $D(i,j)$ can purportedly be uniquely diagnosed. Indeed, the goal of Brodie is to employ the dependency matrix to find the smallest probe subset that can uniquely diagnose a *failure* in any *node*. (See Brodie, Sections 2.1-2.2. and Fig. 2; emphasis added.)

The Examiner contends that:

"Applicant ... argues that Brodie does not teach monitoring links, but monitors nodes instead. However, Brodie clearly discloses monitoring both nodes and links (2.1 Problem Formulation, paragraph 3 – 'If a probe is successful ... link fails to return'.)" (See Examiner's Action, page 8.)

The paragraph to which the Examiner refers states:

2.1 Notation and Approach: Each probe that is sent out either returns successfully or fails to do so. In a noise-free environment, if a probe is successful, then every node and link along its path must be up; conversely, if a node or link is down then any probe passing through that node or link fails to return. Thus r probes result in a "signal"[,] a binary string of length r , each digit denoting whether or not that probe returned successfully (we do not consider exploiting the actual value of the return time if the probe is successful).

The Appellants contend that the above passage of Brodie does not disclose a set of probe messages ... such that the delays and faults in *specific* links [as claimed] can be determined, as recited in Claim 1. At best, the cited passage merely discloses that Brodie can determine that a

failure has occurred in a link or a node in a path, but Brodie does not determine faults in *specific* links.

However, the Examiner states that “1. Introduction, Paragraph 4” of Brodie states: “As a first step towards this goal ... problems anywhere in the network,” and that this discloses the aforementioned elements of Claim 1. The Examiner contends that this preceding paragraph of Brodie discloses: “a set of probe messages ... such that said delays and faults in *specific links* [as claimed] *can be determined*” as recited in Claim 1. (Emphasis added.)

The Appellants respectfully disagree. Brodie, Introduction, Paragraph 4 states in full:

To use probes, probing stations must first be selected at one or more location in the network. Then the probes must be configured; it must be decided which network element to target and which station each probe should originate from. Using probes imposes a cost, both because of the additional network load that their use entails and also because the probe results must be collected, stored and analyzed. Cost-effective diagnosis requires a small probe set, yet the probe set must also provide wide coverage, in order to locate problems anywhere in the network.

However, the Appellants state that the above paragraph of Brodie does not disclose a set of probe messages ... such that the delays and faults in *specific links* [as claimed] can be determined, as recited in Claim 1. Instead, in Brodie, as discussed above, “[t]he goal is to find the smallest probe subset that can uniquely diagnose a *failure* in any *node*.” (See Brodie, Section 2.1, Paragraph 7; emphasis added.)

Indeed, according to Brodie: “*However, this* [locating a failure in any of ‘n’ nodes] *is only achievable if all the necessary links exist in the network and it is possible to guarantee that a probe follows a specified path.*” (See Brodie, Section 2.5, Paragraph 1; emphasis added.) However, in the event of a link failure of Brodie, a probe would *not* follow a specified path. The cited passages of Brodie do *not* disclose a set of probe messages ... such that the delays and faults in *specific links* [as claimed] *can be determined*, as recited in Claim 1. Furthermore, Brodie is silent regarding determining *delays* in specific links, as claimed in Claim 1. The cited passages of Brodie simply do not disclose a set of probe messages ... such that *delays and faults* in *specific links* [as claimed] *can be determined*, as is recited in Claim 1. Moreover, nor have the Appellants been able to find a set of probe messages ... such that *delays and faults* in *specific links* [as claimed] *can be determined* in other passages of Brodie as recited in Claim 1.

According to the M.P.E.P. ¶2131: "To Anticipate a Claim, the Reference Must Teach Every Element of the Claim: 'The identical invention must be shown in as complete detail as in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). This in the Examiner has not done, as the Examiner has not cited where a set of probe messages ... such that the *delays* and *faults* in *specific links* [as claimed] *can be determined*, as recited in Claim 1 and discussed above.

Furthermore, Brodie does not provide an enabling disclosure for Claim 1. As stated in *Elan Pharm.*, a "disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation." (See MPEP ¶2121.01 citing *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). More specifically, Brodie does not enable a set of probe messages ... such that *delays* and *faults* in *specific links* [as claimed] *can be determined*, as recited in Claim 1. The Applicants respectfully state the Examiner's reliance on a citation that Brodie discussing "locat[ing] problems anywhere in the network" is insufficient as disclosing the necessary elements of Claim 1 (see Examiner's Action, page 3), as delineated under MPEP ¶2121.01.

Indeed, as stated above, Brodie states: "*However, this [locating a single failure in any of 'n' nodes] is only achievable if all the necessary links exist in the network and it is possible to guarantee that a probe follows a specified path.*" The Appellants respectfully state that to 'guarantee that a probe follows a specified path' in Brodie is incompatible with computing a set of probe messages ... such that the *delays* and *faults* in *specific links* [as claimed] *can be determined*, as is recited in Claim 1.

For example, according to Brodie, as discussed above, when probing nodes, a signal of binary length "r" is generated, each binary value of the signal "r" denoting whether a corresponding probe returned successfully. (See, Brodie, Section 2.1, paragraph 4.) However, as discussed above, *any* link along the path of a given probe that is down would give rise to an error message for that probe. Brodie would not be able to determine a *specific* link that is down from analyzing its probe messages. Furthermore, the cited portions of Brodie are silent regarding probe messages ... such that the *delays* ... in *specific links* [as claimed] *can be determined*, as recited in Claim 1.

Therefore, the cited passages of Brodie do not disclose each and every element of the claimed invention and as such, is not an anticipating reference. For similar reasons, the cited passages of Brodie do not disclose each and every element of independent Claims 8, 15, 20, and 22. Because Claims 3-6, 10-13, 16-19, and 21 are variously dependent upon Claims 1, 8, 15, and 20, Brodie cannot be an anticipating reference for Claims 3-6, 10-13, 16-19, and 21, either. Accordingly, the Appellants respectfully request the Reviewers to withdraw the §102 rejection with respect to these claims and to allow them to issue.

II. Conclusion

In view of the foregoing remarks, the Appellants now see all of the Claims currently pending in this Application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1, 3-6, 8, 10-13, and 15-22.

The Appellants request the Reviewers to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present Application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in dark ink, appearing to read 'D. Hitt', with a large, stylized initial 'D'.

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Dated: August 21, 2008

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